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EXAMINER
PRIETO, BEATRIZ

ART UNIT	PAPER NUMBER
2142	

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _29 April 2003_ .

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _26-43_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _26-43_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6) ☐ Other: .

DETAILED ACTION

1. This communication is in response to amendment filed 4/29/03, claims 26-43 remain pending and are hereby set forth for examination.

2. In regards to the claim limitation "without accessing a remote search engine", it is noted that it is required that boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim must comply with the requirements of 35 U.S.C. 112, second paragraph. In this case, a negative limitation renders the claim indefinite because it was an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). The negative limitation was added with the intention to define the invention in terms of what it was not, rather than pointing out the invention. Any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not basis for an exclusion. See MPEP § 2163 - § 2163.07(b) for a discussion of the written description requirement of 35 U.S.C. 112, first paragraph. (see MPEP 2173.05(i) Negative Limitations).

CLAIM REJECTION §112

3. The following is a quotation of the first paragraph of 35 U.S.C. §112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26, 32, 36 and 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, claim contains a negative limitation which does not have basis in the original disclosure.

4. Claims 26, 32, 36 and 40 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In this case, an

explicit written description of claim limitation "subject index nested within a verb index and a provider index nested within said subject index" is not found in the disclosure. Applicant is urged to specifically point out where the disclosure contains a written description of said limitation(s).

5. Claims **26-43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubenstein et. al. (Rubenstein) U.S. Patent NO. 5,913,215 in view of Osaku et. al. (Osaku) U.S. Patent No. 6,061,738

Regarding claim 32,

a software ("software package") (col 2/lines 58-61) including an user interface within an application program (col 18/lines 55-col 19/lines 29) and including said software package including a information ("network content index") having a verb ("verb index"), subject ("subject index") (Fig. 2, words 206 in index 205) and destination ("provider") (Rubenstein, col 2/lines 28-43, 63-67, words/phrases, including URLs, col 12/lines 45-66);

said software package for facilitating client side construction of a navigation sentence of pre-configured sentence parts (Rubenstein, abstract, sentence parts, col 2/lines 28-67) through the selection of a word ("verb") from an index (Fig. 2, words 206 in index pane, 205, Fig. 12, "order", or "obtain"), a word ("subject") from an index (Fig. 2, words 206 in index pane, 205, Fig. 12, "news") and a destination (" provider") thereby designating a destination (col 12/lines 45-66, Fig. 6, e.g. web site address 610),

wherein network content is retrieved from said destination based on said navigation sentence and a network navigation destination instruction (Rubenstein, col 4/lines 19-23, 27-31, Url);

however Rubenstein does not explicitly teach where a said software package is downloaded to a client data processing system,

Osaku teaches a communication data/access retrieval system/method for accessing information via a network navigation instruction (URL), teaching means for accessing a network location to receive and download a software package (col 24/lines 48-col 25/line 1) at the client processing system thereby running thereon;

It would have been obvious to one ordinary skilled in the art at the time the invention was made to utilize Osaku's teachings for downloading a software package to the client data processing system for facilitating and providing said sentence parts for facilitating the construction of a navigation sentence as taught by Osaku, and further applied to such hierarchical structures for user selection of records from such structures, such as electronic file storage directory structures, including hypertext pages on a Web sites, well know in the art[1], motivation would to download said software package to the client data

processing system, along with the archive catalog Rubenstein suggest can be obtained from a remote web sites.

Regarding claim 26, Rubenstein teaches features of the invention substantially as claimed, teaching a system/method including:

a server computer ("server data processing system") having a database storing a information ("network content index") (col 2/lines 28-33, 52-55) having a data structure (col 14/lines 27-40); and

a client computer (400 of Fig. 4)("client data processing system") communicatively connected to said server data processing system (col 9/lines 29-col 10/line 15) via a network ("electronic data network") (col 9/lines 65-67) and configured a program to access said server data processing system to load said network content index into a local storage facility (col 14/lines 34-40),

said program to facilitate construction of a navigation sentence of sentence parts (Rubenstein: abstract, sentence parts col 2/lines 28-67) via user selection of a word ("verb") from an arrangement or record (i.e. index) (Fig. 2, words 206 in index pane, 205, Fig. 12, "order"), selection of a word ("subject") an arrangement or record (index) (Fig. 2, words 206 in index pane, 205, Fig. 12, "news"), and selection of a destination ("provider") from an arrangement or record ("index") (col 12/lines 45-66, Fig. 6, e.g. web site address 610),

wherein said client data processing system retrieves network content based on said navigation sentence and said destination thereof (Rubenstein, col 4/lines 19-23, 27-31, Url).

Regarding claim 27, wherein said client data processing system retrieves said network content via a WWW site (Rubinstein, abstract) and said electronic data network (Rubenstein, col 9/lines 65-67).

Regarding claim 28, wherein said destination includes a link to content accessible via said electronic data network, said at least one program further configured to traverse said link (Rubenstein, col 14/lines 27-40).

Regarding claim 29, wherein said link is a uniform resource locator (URL) (Rubenstein, col 14/lines 27-40, 47-56).

Regarding claim 30, wherein the selection of said verb, subject, and said provider is realized via pull-down dialogs within a graphical user interface provided within said client data processing system (Rubenstein, col 5/lines 31-43, Figs. 2-3, 5-7 and 10-15).

Regarding claim 31, wherein said graphical user interface is provided with a WWW site review window (Rubenstein, col 4/lines 19-31) of a running WWW browser package (Rubenstein, col 14/lines 47-56).

Regarding 33, said navigation instruction is a (URL) (Rubenstein, col 4/lines 19-31).

Regarding claim 34, wherein selection of said pre-configured sentence parts is realized via pull-down dialogs within a graphical user interface provided within a client data processing system (Rubenstein: e.g. Figs 2-3, 5-7 and 10-15, col 5/lines 31-43).

Regarding claim 35, wherein said graphical user interface is provided with a WWW site review window (Rubenstein, col 4/lines 19-31) of a running WWW browser software package (Rubenstein, col 14/lines 47-56).

Regarding claim 36,
       downloading a software package (Osaka: col 24/lines 48-col 25/line 1) having a searchable network content index from an accessed network to a local computer, (Rubenstein, abstract, col 2/lines 28, col 12/lines 45-66, searchable web pages, abstract) said searchable network content index having a data structure (e.g. web sites databases, abstract, pages, col 1/lines 55-60);
       said software package providing a user with a verb menu listing said verb index for selecting a verb from said verb index in said subject index (Rubenstein: Fig. 2, words 206 in index pane, 205, Fig. 12, "order", or "obtain");
       said software package providing a user with a subject menu listing a portion of said subject index corresponding to said verb for selecting a subject from an index ("subject index") (Rubenstein: Fig. 2, words 206 in index pane, 205, Fig. 12, "news");
       said software package providing a user with a provider in menu listing a portion o f said provider index corresponding to said subject for selecting a provider from said provider index (Rubenstein: col 12/lines 45-66, Fig. 6, e.g. web site address 610), and accessing a destination instruction via an Internet address (URL) that uniquely corresponds to said provider (Rubenstein: col 12/lines 45-66, Fig. 6, e.g. web site address 610).

Regarding claim 37, wherein accessing said network is initiated within a client-side system running in accordance with a WWW browser software application (Rubenstein, col 9/lines 65-col 10/line 2).

Regarding claim 38, wherein downloading said software package network is initiated within a client-side system running in accordance with a WWW browser software application (Osaka: col 24/lines 48-col 25/line 1).

Regarding claim 39, wherein said destination instruction is a URL, (Rubenstein, col 4/lines 19-31).

Regarding claim 40, this claim comprises limitations that are substantially the same as those in claims 26, 32, 36, same rationale of rejection is applicable.

Regarding claims 41-43, theses claims are substantially the same as those on claims 37-39, respectively same rationale of rejection is applicable.

Pertinent Prior Art:

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure; pertinence is presented in accordance with to MPEP§ 707.05. Copies of documents cited will be provided as set forth in MPEP§ 707.05(a):

Ref (1) U.S . Patent No. 5,790,121 (08-1998)

SKLAR et. al. teach hierarchical structures for user selection of records from such structures, such as electronic file storage directory structures, plain hypertext pages on a Web site, or an intranet, wherein the hierarchical information is typically processed by many search engines or searching Worldwide Web sites. For example, a large URL database such as YAHOO!'s database (http://www.yahoo.com/) would provide too many references matching the word "team" (subject) to be of use to a searcher. The clustering user interface of the present invention and a starting point, such as the "Oakland Raiders" subcategory of Yahoo!'s hierarchical subject database, the user could be presented with all the hits, where many of the hits are clustered into a single entry (col 3/line 39-col 40/line 9).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Prosecution of this application is closed by means of this final office action § 1.113, applicant may request continued examination of the application by filing a Request for Continued Examination of under 37 CFR § 1.114 and providing the corresponding fee set forth in § 1.17(e) for the submission of, but not limited to, new arguments, an information disclosure statement, an amendment to the written description, claims, drawings, or new evidence in support of patentability. Or applicant whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences under 35 U.S.C. §134.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Mark R. Powell can be reached on (703) 305-9703. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6606. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Any response to this final action should be mailed to:
>   **Box AF**
>   Commissioner of Patents and Trademarks
>   Washington, D.C. 20231

or Faxed to:
>   (703) 746-7238 for TC 2100 Official After-final communications; please mark "EXPEDITED PROCEDURE", and
>   (703) 746-7239 for other TC 2100 Official communications.
or:
>   (703) 465-7240 for Non-Official, Draft communications, status query, please

label "PROPOSED" or "DRAFT".

Or Telephone:
>   (703) 306-5631 for TC 2100 Customer Service Office

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

B/Prieto
TC 2100
Patent Examiner

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